

Remarks

Applicant appreciates the withdrawal of the finality of the previous Office Action. In the non-final Office Action dated January 5, 2009, the following new grounds of rejection are present: claims 1, 5, 10-13, 16 and 19 stand rejected under 35 U.S.C. § 103(a) over Paratore (U.S. Patent No. 6,294,997); claim 4 stands rejected under 35 U.S.C. § 103(a) over the '997 reference in view of Heinrich (U.S. Patent No. 6,404,325); claims 14-15 stand rejected under 35 U.S.C. § 103(a) over the '997 reference in view of Heinrich (U.S. Patent No. 6,812,841); claims 17-18 stand rejected under 35 U.S.C. § 103(a) over the '997 reference in view of Forster (U.S. Patent No. 7,224,273). Claims 2-3 and 6-9 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form. In response thereto Applicant has rewritten claims 2-3 and 6-7 in independent form and amended claim 4 to depend from claim 2 and claim 10 to depend from claim 6. Thus, Applicant submits that claims 2-4 and 6-10 are in condition for allowance. The Office Action also objects to the drawings as lacking descriptive text labels. Applicant traverses all of the rejections and, unless explicitly stated by Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Applicant has cancelled claims 1 and 5 in an effort to facilitate prosecution; however, Applicant traverses the rejections of those claims for failing to show correspondence to each limitation. The '997 reference does not determine a time and then correct for the determined time using discharge characteristics. The Office Action has not presented any teachings that determine a time and then correct the time using discharge characteristics. Each of the alleged corresponding teachings involve changes to the initial discharge rate (*e.g.*, resistor values changing due to temperature) and therefore fail to correct a time that has been determined. Accordingly, the rejections are improper; however, Applicant has cancelled claims 1 and 5 to facilitate prosecution. Applicant reserves the right to pursue such claim scope in the future (*e.g.*, through a continuation application).

Applicant respectfully traverses the rejections of claims 11-21 for failing to show correspondence to each limitation. Applicant respectfully traverses the Examiner's improper use of *St. Regis Paper Co. v. Bemis Co.*, 193 U.S.P.Q. 8 (CCPA 1977). This case applied to mere duplication of elements. Merely duplicating the capacitor of the '997 reference would not result in correspondence to the claim limitations, including those

directed toward correction of a first timing. Merely duplicating a capacitor would simply provide identical timing. The claims require both determining a time and correcting the time. As explained above, the '997 reference has not been shown to teach or suggest such aspects. Moreover, the claims require two starting times, one for each capacitor. Thus, the reliance upon *St. Regis Paper* is improper because the capacitors are not merely duplicated. As taught by Applicant's specification and as claimed, the circuit is designed to use the capacitors for different functions including different discharge start times. Accordingly, the second capacitor is not a mere duplication of the first capacitor and there is not a *prima facie* case of obviousness.

The M.P.E.P. explains that an examiner must weigh all the evidence of record when determining whether it is more likely or not that the claimed invention as a whole is patentable. M.P.E.P. § 706. This is also the standard used by both the U.S.P.T.O. Appeal Board and the U.S. courts when reviewing a final office action. The M.P.E.P. and *KSR* stress the import of providing analysis in addition to finding individual elements of a claim.

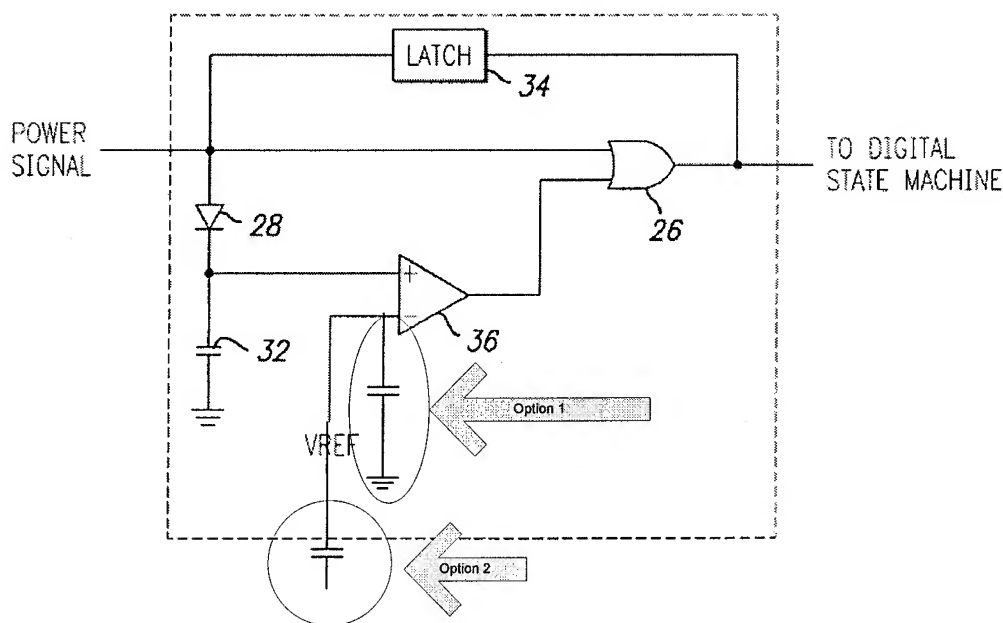
Applicant respectfully submits that the Office Action is improperly selecting elements used for unrelated purposes and alleging correspondence without considering the invention as a whole. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)." M.P.E.P. § 2141.02. This was further underscored by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (U.S. 2007). "(I)nventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *KSR* at 418-419. As explained in *KSR*, all inventions are made up of elements that are in some sense known. An examiner will therefore always be able to find the individual elements of an invention in some form or another. The most important analysis is therefore not finding and identifying the elements of a claim. Rather, it is necessary to consider the context of how the elements are used and consider the invention as a whole. To this end, the claimed invention needs to be considered as a whole rather than breaking the differences down to individual elements and addressing

the claim limitations individually. Applicant requests consideration of at least the following factors under this standard.

Applicant is unable to determine how the '997 reference and the '841 reference are taught to be combined in a manner that corresponds to the claim limitations. The Office Action appears to suggest that the Vref signal be coupled to a second capacitor. This is illogical and not taught or suggested by either reference. Vref is a reference voltage used to determine whether to output a one or a zero and has no corresponding signal in the '997 reference. *See* '841 reference, Col. 5:51-65. The Office Action asserts that adding this capacitor prevents stray leakage related to capacitor 32; however, Applicant submits that the additional capacitor would have no appreciable effect on the stray leakage of capacitor 32. Moreover, the '841 reference does not suggest the addition of a capacitor to the Vref line. The skilled artisan would recognize that the reference voltage of the '841 reference is a reference voltage to determine a data zero or data one output. Neither reference, nor the Office Action suggests a logical reason for adding a capacitor to this reference voltage. Applicant notes that stray leakage of capacitor 32 is a concern of the '841 reference, but is not taught to be prevented by the circuit of the '841 reference, and even if it was, a capacitor placed on the Vref signal is unrelated to leakage of the capacitor 32.

Applicant expresses confusion as to what the Office Action is attempting to create with the combination of unrelated elements of the references and the unsubstantiated reason for the combination. As best as can be determined, there are two main options for adding a capacitor to Vref. Neither of these options is suggested or desirable in view of the teachings of the cited references nor would the options help prevent leakage current from capacitor 32. Option 1 involves a capacitor connected in a manner that would filter high frequency components from the signal. Option 2 involves a capacitor connected in a manner that would filter low frequency components from the signal. Neither capacitor setting would correspond to Applicant's claim limitations directed to correcting disconnection time information using a second capacitor. Applicant has reproduced these options for the proposed modification below to illustrate the undesirability of the modification.

FIG. 3



- Modified options of the '841 reference, FIG. 3.

Applicant further submits that the circuit of the '841 reference is not combinable with the circuit of the '997 reference and that no discernable combination would correspond to the claim limitations. The two disparate circuits each use one capacitor to perform different functions. Thus, to the extent that a combination would include multiple capacitors, they would be substantially unrelated in function and assuredly be unrelated to Applicant's claim limitations. For simplicity, Applicant has reproduced the two circuits side by side to show the independence of the circuits. Applicant is unable to understand how the Office Action believes these circuits are suggested to be combined. Applicant further explains this confusion in the discussion following the reproduced figures.

FIG. 3

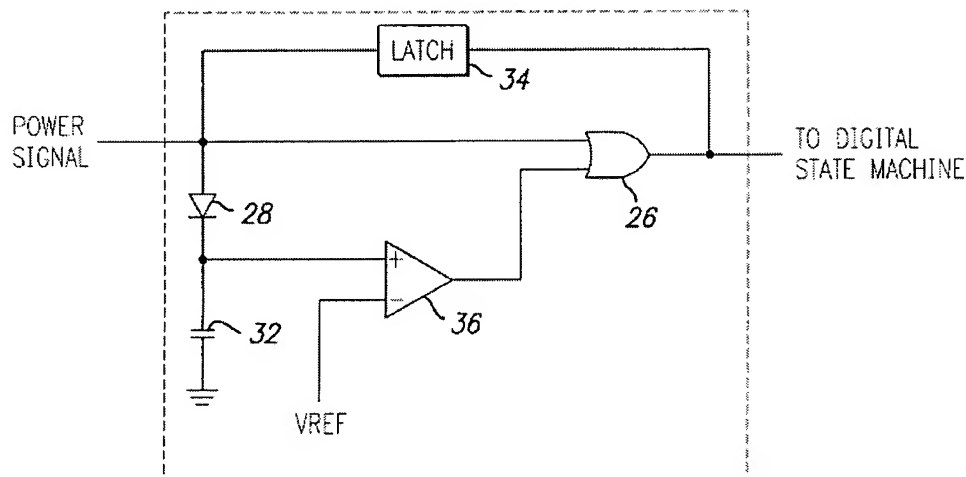
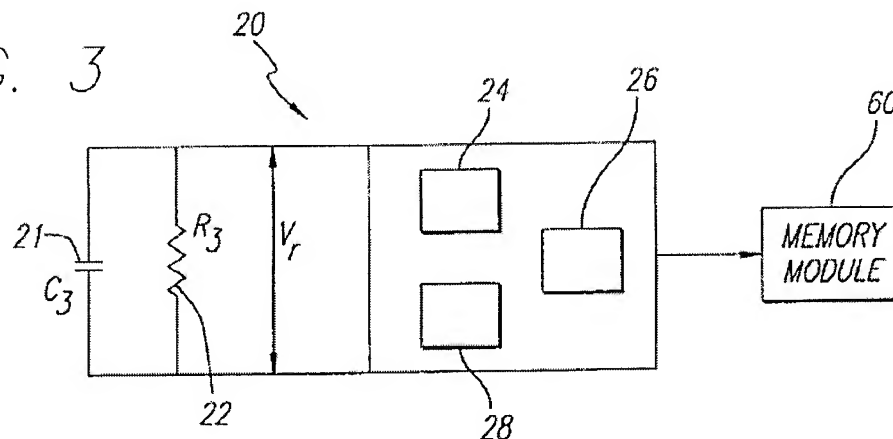


FIG. 3



- '841 reference, FIG. 3; '997 reference, FIG. 3.

These circuits have no readily apparent combinability. The circuits provide unrelated functions and the evidence strongly suggests that the skilled artisan would not seek to combine the circuits; moreover, no evidence suggests that a hypothetical combination would be consistent with the claim limitations. The relied upon portions of the '841 reference relate to a state holding cell designed to store information when power is removed by maintaining charge on a capacitor. The relied upon portions of the '997 reference are designed to intentionally discharge a capacitor to provide timing information. The primary '997 reference uses a capacitor discharge to calculate a timing parameter, while the secondary '841 reference uses a capacitor to store a memory value. The Office Action provides little explanation for how the circuits would be combined. The Office Action also fails to provide a substantive reason to combine the elements in a manner consistent with

Applicant's claims as a whole. The Office Action does identify elements from the individual circuits, but stops short of providing an explanation for a logical combination of the elements. Without such an explanation, there is insufficient evidence to establish a *prima facie* case of obviousness, for which it is important to provide an articulated explanation for the rejection that explains the "steps that a person of ordinary skill in the art would employ." *KSR* at 418.

Applicant has shown that the combination would not correspond to the claim limitations, that the proposed modification is illogical and that the proposed reason for the combination is illogical. A *prima facie* case of obviousness requires substantially more than identification of individual elements with a loose assertion of combinability. Applicant requests that the Examiner reconsider the patentability in view of all evidence and to view the claimed invention as a whole. Applicant believes that the evidence of patentability is significantly more than any evidence of unpatentability and requests that the rejections of each of the claims be withdrawn.

Applicant appreciates the attention to detail and suggestions regarding the figures but is uncertain of the basis of the rejection and therefore traverses the objection. Applicant submits that the Office Action fails to identify the basis for the objection in the M.P.E.P. rules and does not explain the objection to the drawing. C.F.R. 1.83(a) states that: "conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (*e.g.*, a labeled rectangular box)." The rectangular boxes of Applicant's figures contain the suggested (alphanumeric) textual labels, which are further explained in the Specification. In Applicant's experience, the use of rectangular boxes with alphanumeric labels is commonly accepted practice for U.S.P.T.O. applications. Applicant believes that the figures conform to the relevant U.S.P.T.O. rules. If the Examiner believes that some unidentified U.S.P.T.O. rules are relevant, Applicant requests clarification and explanation.

In view of the remarks above, Applicant believes that each of the rejections/objections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9063.

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